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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ANDREW L. GROSS, MARK E. HILL, GERALD D. JOHN,  
CHARLEY D. LILLARD, and DOUGLAS E. TORRENS

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Appeal No. 1997-3425  
Application No. 08/087,824

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ON BRIEF

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Before, JERRY SMITH, BARRETT, and BARRY, Administrative Patent Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 1, 3, 4, 6-8, and 10-13. We reverse.

Appeal No. 1997-3425

Application No. 08/087,824

BACKGROUND

The rapidity with which data processing systems are developed and enhanced has created the need to upgrade software employed in the systems. Software installation packages automate the performance of such upgrades. An inherent danger in such automation is that an updated or enhanced version of software may not operate properly with other software in a system. Without having created a backup of the previous version of the software, a user cannot reverse such an upgrade.

The invention at issue in this appeal automates the installation of software in a way that is selectively reversible and does not require a user to create a backup of software. It also maintains and catalogues versions of software within tape drives. Specifically, the invention employs a removable tape cartridge that includes at least one alternate version of selected software. When the cartridge is inserted into a tape drive, the user is prompted to select an alternate version of the selected software for installation. Before installing the alternate version, the version currently

used in the drive is automatically copied to the cartridge so that the installation may be selectively reversed. A directory within the cartridge is automatically created and updated each time software is copied to or from the cartridge. The directory catalogues each alternate version of the software, a required hardware level for use with each version, and a listing of each drive that has used the version.

Claim 1, which is representative for our purposes, follows:

1. A method for reversibly installing a software application within a data processing system among a plurality of data processing systems, said data processing system having a processor, memory containing a first version of a selected software application and a storage system for receiving a removable storage medium, said method comprising the steps of:

inserting said removable storage medium containing at least one alternate version of said selected software application within said storage system;

prompting a user of said data processing system to select an alternate version of said selected software application for installation within said data processing system utilizing said storage system;

automatically copying said first version of said selected software application from said memory onto said removable storage medium prior to initiation of installation of an alternate version of said selected software application in response to said selection thereof wherein said installation may be selectively reversed; and

creating a directory within said removable storage medium listing each alternate version of said selected software application contained therein and a unique identification of each data processing system among said plurality of data processing systems which has utilized each of said alternate versions of said selected software application.

The references relied on in rejecting the claims follow:

Cwiakala et al. (Cwiakala)	5,257,379	Oct. 26, 1993
	(filing date Nov. 4,	
1991)		
Bealkowski et al. (Bealkowski)	5,355,489	Oct. 11, 1994
	(filing date Mar. 26,	
1991)		
Fisher et al. (Fisher)	5,367,686	Nov. 22, 1994
	(filing date Apr. 12,	
1993)		

Microsoft® MS-DOS® Operating System version 5.0 Getting Started (user manual), Microsoft Corporation 1991.

Claims 1, 3, 6, 7, 8, 11, 12, and 13 stand rejected under 35 U.S.C. § 103 as obvious over Microsoft in view of Fisher.

Claim 4 stands rejected under 35 U.S.C. § 103 as obvious over Microsoft in view of Cwiakala further in view of Fisher.

Claim 10 stands rejected under 35 U.S.C. § 103 as obvious over

Microsoft in view of Bealkowski further in view of Fisher. Rather than repeat the arguments of the appellants or examiner in toto, we refer the reader to the briefs and answers for the respective details thereof.

#### OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejections advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellants and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 1, 3, 4, 6-8, and 10-13. Our opinion addresses the interpretation and obviousness of the claims.

#### Interpretation of the Claims

The language of the claims requires interpretation. "Claims are not interpreted in a vacuum, but are part of and are read in light of the specification." Slimfold Mfg. Co. v. Kinkead Indus., Inc., 810 F.2d 1113, 1116, 1 USPQ2d 1563, 1566 (Fed. Cir. 1987) (citing Hybritech Inc. v. Monoclonal

Anti-bodies, Inc., 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986); In re Mattison, 509 F.2d 563, 565, 184 USPQ 484, 486 (CCPA 1975)). Here, claims 1, 3, 4, 6-8, and 10-13 each specifies in pertinent part a "plurality of data processing systems." Each of the data processing systems, moreover, is specified as including a "processor" and a "memory ... containing a first version of ... selected software." Furthermore, claims 1, 3, 4, 6-8, and 10-13 each also specifies in pertinent part a "directory ... listing each alternate version of said selected software application contained therein and a unique identification of each data

processing system among said plurality of data processing systems which has utilized each of said alternate versions of said selected software application."

The specification defines a "microcode replacement directory **40** .... " (Spec. at 10.) Figure 2 of the specification shows that the directory "includes multiple columns containing selected information with respect to the various versions of microcode which are available and which have been installed." (Id.) In particular, "column **56** lists each tape drive within an enterprise which either currently or had previously utilized a particular microcode level." (Spec. at 11.) The specification adds, "tape drive **16** preferably includes a controller **20** which ... includes a processor **22** ... and a section of programmable memory **26**." (Spec. at 8.)

Reading the claims in light of the specification, the claimed "plurality of data processing systems" refers to a plurality of the tape drive 16. In addition, the claimed



"processor" refers to processor 22; the claimed "memory ... containing a first version of ... selected software," refers to programmable memory 26. Furthermore, the claimed "directory ... listing each alternate version of said selected software application contained therein and a unique identification of each data processing system among said plurality of data processing systems which has utilized each of said alternate versions of said selected software application" refers to microcode replacement directory 40 which includes column 56. Next, we address the obviousness of the claims.

#### Obviousness of the Claims

We begin by noting the following principles from In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. Id. "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested

the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With these in mind, we analyze the examiner's rejection.

The examiner makes the following observations.

[T]he [Microsoft] Getting Started manual explicitly states on page 6 that it "*saves your previous MS-DOS files in a directory called OLD\_DOS.*" In addition, the Getting Started manual explicitly states on page 6 that it stores information about the previous version of MS-DOS on one or two disks labeled *Uninstall 1 and Uninstall 2*. The information stored on these floppy disks ... makes it possible to restore ... the previous version of MS-DOS. Furthermore, the *Uninstall 1 and Uninstall 2* disks save copies of the previous version CONFIG.SYS and AUTOEXEC.BAT files which contain system and platform specific information. (Examiner's Answer at 11.)

He explains, "All MS-DOS storage media use a directory format ...." (Id. at 12.) "The MS-DOS directory format," adds the examiner, "shows ... a volume label, volume serial number, drive letter (c:\), and directory path (c:\windows)." (Id.)

He notes, "when personal computers are networked together the concept of a shared drive (physically located elsewhere)

is well-established in the art." (Supplemental Examiner's Answer at 1.) The examiner argues, "the s:\ shared drive letter and directory path clearly distinguish a particular data processing system from among a plurality of data processing systems ...." (Id. at 2.)

The appellants make the following reply.

Clearly, the drive letter and directory path do not characterize a particular data processing system from among a plurality of data processing systems. Further, the volume label and volume serial number cannot be said to characterize uniquely a data processing system from among a plurality of data processing systems as the volume label, or "volume name" is a name for a disk or tape, usually assigned by the user when the disk or tape is formatted.  
(Reply Br. at 2.)

As mentioned regarding the interpretation of the claims, claims 1, 3, 4, 6-8, and 10-13 each specifies in pertinent part the following limitations: "a directory ... listing each alternate version of said selected software application contained therein and a unique identification of each data processing system among said plurality of data processing systems which has utilized each of said alternate versions of

said selected software application." Reading the claims in light of the specification, the limitations recite a directory that lists alternate versions of a software application and each tape drive, among a plurality of tape drives, that has used each of the versions.

The examiner fails to show a teaching or suggestion of the claimed limitations. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 519 U.S. 822 (1996) (citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). The mere fact that prior art may be modified as proposed by an examiner does not make the modification obvious unless the prior art suggested the desirability thereof. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Microsoft teaches saving "previous MS-DOS files in a directory," p. 6, and "stor[ing] information about your previous versions of MS-DOS on one or two disks." Id. Regarding the later information, the reference specifically mentions "cop[ying] your previous version of CONFIG.SYS and AUTOEXEC.BAT files to the Uninstall disks ...." Id. The

examiner has not shown that either the previous MS-DOS files  
or the previous

version of CONFIG.SYS and AUTOEXEC.BAT files, however, lists alternate versions of a software application and each tape drive, among a plurality of tape drives, that has used each of the versions.

For its part, Fisher teaches "the creation of an installation profile which contains all of the preset options and characteristics of a selected data processing system which are necessary to automatically install a complex multilevel software application within that data processing system ...." Col. 5, ll. 48-53. The examiner has not shown that such an installation profile, however, lists alternate versions of a software application or each tape drive, among a plurality of tape drives, that has used each of the versions.

Neither the addition of Cwiakala nor Bealkowski cures the defects of Microsoft and Fisher. The examiner has not identified anything in these references or the prior art as a whole that teaches or would have suggested listing alternate versions of a software application or each tape drive, among a plurality of tape drives, that has used each of the versions.

For the foregoing reasons, we are not persuaded that teachings from the prior art would appear to have suggested the claimed limitation of a directory that lists alternate versions of a software application and each tape drive, among a plurality of tape drives, that has used each of the versions. The examiner impermissibly relies on the appellants' teachings or suggestions; he has not established a prima facie case of obviousness. Therefore, we reverse the rejection of claims 1, 3, 4, 6-8, and 10-13 under 35 U.S.C. § 103.



CONCLUSION

To summarize, the rejection of claims 1, 3, 4, 6-8, and  
10-13 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
LANCE LEONARD BARRY	)	
Administrative Patent Judge	)	

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APPEAL NO. 1997-3425 - JUDGE BARRY

APPLICATION NO. 08/087,824

APJ BARRY

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APJ

DECISION: **ED**

Prepared by: Gloria Henderson

**DRAFT TYPED:** 10 Sep 02

**FINAL TYPED:**

Team 3, please note the following instructions:

Do NOT change style of citations.

Do insert full names of all inventors

Do insert reference(s).

Do add a mailing address

Do check quotations and citations.

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Thank you.